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PCT

Docket No. TIP-0044-USPCT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Goeman et al.

Serial No. : 10/540,057

Art Unit: Unassigned

Filed : June 22, 2005

Examiner: Unassigned

For : FLUOROGENIC ENZYME SUBSTRATES AND METHODS OF
PREPARATION

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June 28, 2006

(Date of Deposit)

Laura A. Donnelly

(Name of applicant, assignee, or Registered Representative)

/Laura A. Donnelly/

(Signature)

June 28, 2006

(Date of Signature)

MAIL STOP DD
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

INFORMATION DISCLOSURE STATEMENT

Dear Sir:

Pursuant to 37 C.F.R. §1.56 and in accordance with 37 C.F.R. §§1.97-1.98, information relating to the above-identified application is hereby disclosed. Inclusion of information in this statement is not to be construed as an admission that this information is material as that term is defined in 37 C.F.R. §1.56(b).

Applicant(s) reserve(s) the right to establish the patentability of the claimed invention over any of the information provided herewith, and/or to prove that this information may not be prior art, and/or to prove that this

information may not be enabling for the teachings purportedly offered.

This statement should not be construed as a representation that a search has been made, or that information more material to the examination of the present patent application does not exist.

☒ In accordance with §1.97(b), since this Information Disclosure Statement is being filed either within three months of the filing date of the above-identified national application (other than a continued prosecution application under §1.53(d)), within three months of the date of entry into the national stage of the above identified application as set forth in §1.491, or before the mailing date of a first Office Action on the merits of the above-identified application, or before the mailing date of a first Office Action after the filing of a request for continued examination under §1.114, no additional fee is required.

☐ In accordance with §1.129(a), this Information Disclosure Statement is being filed in connection with ☐ the first or ☐ second After Final Submission, therefore:

☐ Statement in Accordance with §1.97(e) (attached); or

☐ Please charge Deposit Account No. 10-0750/ / the fee of \$180.00 as set forth in §1.17(p).

☐ In accordance with §1.97(c), this Information Disclosure Statement is being filed after the period set forth in §1.97(b) above but before the mailing date of either a Final Action under §1.113 or a Notice of Allowance under §1.311, or an action that otherwise closes prosecution and that it is accompanied by one of:

- ☐ Statement in Accordance with §1.97(e) (attached); or
- ☐ Please charge Deposit Account No. 10-0750/ / the fee of \$180.00 as set forth in §1.17(p).

☐ In accordance with §1.97(d), this Information Disclosure Statement is being filed after the mailing date of either a Final Action under §1.113 or a Notice of Allowance under §1.311 but before the payment of the Issue Fee. Applicant(s) hereby petition(s) for consideration of this Information Disclosure Statement. Included are: Statement in Accordance with §1.97(e) as set forth below and the fee of \$180.00 as set forth in §1.17(p).

☐ Copies of each of the references listed on the attached Form PTO-1449 are enclosed herewith.

☐ Copies of references listed on the attached Form PTO-1449 are enclosed herewith EXCEPT THAT:

☐ In view of the voluminous nature of references [list as appropriate], and the likelihood that these references are available to the Examiner, copies are not enclosed herewith.

☐ If any of the foregoing publications are not available to the Examiner, Applicant will endeavor to supply copies at the Examiner's request.

☒ Copies of only foreign patent documents and non-patent literature are enclosed in accordance with 37 CFR 1.98 (a) (2).

☐ There are no listed references which are not in the English language.

☒ The relevance of those listed references which are not in the English language is as follows: NL 6 409 642 A (American Cyanamid Company, 21 February 1996 (1996-02-21)).

☒ Attached are copies of search report(s) from corresponding patent application(s), which are listed on the attached Submission Under MPEP 609 D (International Search Report PCT/EP03/51105 dated 23 November 2004).

☐ Attached are the following non-published pending patent applications which may be deemed relevant, which are listed on the attached Submission Under MPEP 609 D.

Please charge any deficiency or credit any overpayment to Deposit Account No. 10-0750/TIP-0044-USPCT/LAD. This form is submitted in triplicate.

Respectfully submitted,

/Laura A. Donnelly/

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DATED: June 28, 2006

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Substitute for form 1449A/PTO

**INFORMATION DISCLOSURE
STATEMENT BY APPLICANT**

(use as many sheets as necessary)

Sheet 1 of 2

Application Number	10/540,057
Filing Date	June 22, 2005
First Named Inventor	Jan Ludwig Goeman
Group Art Unit	Unassigned
Examiner Name	Unassigned
Attorney Docket Number	TIP-0044-USPCT

U.S. PATENT DOCUMENTS

Examiner Initials	Cite No. ¹	U.S. Patent Document		Name of Patentee or Applicant of Cited Document	Date of Publication of Cited Document mm-dd-yyyy	Pages, Columns, Lines, where relevant passages or relevant figures appear
		Number	Kind Code ² (if known)			
		5,443,986	A	Haughland et al.	08-22-1995	
		4,159,330	A	Como et al.	06-26-1979	

FOREIGN PATENT DOCUMENTS

Examiner Initials	Cite No. ¹	Foreign Patent Document			Name of Patentee or Applicant of Cited Document	Date of Publication of Cited Document mm-dd-yyyy	Pages, Columns, Lines, where relevant passages or relevant figures appear	T ⁶
		Office ³	Number ⁴	Kind Code ⁵				
		EP	0722937	A	Bayer AG	07-24-1996		
		WO	93/04077	A	Molecular Probes Inc.	03-04-1996		
		WO	02/28841	A	Molecular Probes Inc.	04-11-2002		

Examiner Signature	Date Considered
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*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

¹ Unique citation designation number. ² See attached Kinds of U.S. Patent Documents. ³ Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). ⁴ For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. ⁵ Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST. 16 if possible. ⁶ Applicant is to place a check mark here if English language Translation is attached.

Burden Hour Statement: This form is estimated to take 2.0 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U. S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS, SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450

Substitute for form 1449A/PTO INFORMATION DISCLOSURE STATEMENT BY APPLICANT (use as many sheets as necessary) Sheet 2 of 2	Application Number	10/540,057
	Filing Date	June 22, 2005
	First Named Inventor	Jan Ludwig Goeman
	Group Art Unit	Unassigned
	Examiner Name	Unassigned
	Attorney Docket Number	TIP-0044-USPCT

OTHER PRIOR ART - NON PATENT LITERATURE DOCUMENTS			
Examiner's Initials*	Cite No. ¹	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published	T ²
		Bolotin et al., "2-Aryl-4H-3, 1-benzoxazin-4-ones and their analogs. II. Some Reactions of O-Acylaminobenzamides", Chemical Abstracts, vol. 70, no. 17, 1969, Columbus, Ohio, US; abstract no. XP002257309 & ZH. VSES. KHIM. OBSCHEST., vol. 13, no. 4, pp. 475-476 (1968)	
		Patent Abstracts of Japan, vol. 2002, no. 5, May 3, 2002 & JP 2002 030085 A (Asahi Glass Co Ltd., Mitsubishi Pharma Corp.), January 29, 2002 abstract	
		Diwu et al., "Spectral Properties and Biological Applications of ELF Enzyme Substrates that yield Fluorescent Precipitates at the Enzymatic Activity Sites", Proceedings of SPIE - The International Society for Optical Engineering 3602 Advances in Fluorescence Sensing Technology IV, 1999, pages 265-274 (XP008023235)	
		Diwu et al., Fluorescent Molecular Probes I. The Synthesis and Biological Properties of an ELF beta-Glucuronidase Substrate That Yields Fluorescent Precipitates at the Enzymatic Activity Sites", Tetrahedron, Elsevier Science Publishers, Amsterdam, NL, vol. 53, no. 21, 26 May 1997, pages 7159-7164 (XP004105695)	
		Naleway et al., "Synthesis and Use of New Fluorogenic Precipitating Substrates", Tetrahedron Letters, vol. 35, no. 46, 14 November 1994, pages 8569-8572 (XP002230449)	
		Zhou et al, "A Fluorogenic Substrate for beta-Glucuronidase: Applications in Fluorometric, Polyacrylamide Gel and Histochemical Assays", Journal of Biochemical and Biophysical Methods, vol. 33, 1996, pages 197-205 (XP002230450)	
		NL 6 409 642 A (American Cyanamid Company), 21 February 1966	
		Proceedings of SPIE - The International Society for Optical Engineering - "Advances in Fluorescence Sensing Technology IV", 1999, pages 265-274 (XP008023235)	

Examiner Signature		Date Considered	
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<p align="center">SUBMISSION UNDER MPEP 609 D</p> <p align="center">Page 1 of 1</p>	<i>Application Number</i>	10/540,057
	<i>Filing Date</i>	June 22, 2005
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	<i>Attorney Docket Number</i>	TIP-0044-USPCT

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		International Search Report mailed 23 November 2004 for PCT/EP03/51105	

Examiner Signature		Date Considered	
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